



May 6, 2002

In re Patent Application of:

John C. Harvey and
James W. Cuddihy

Application No.: 08/470,571

Filed: June 6, 1995

Title: SIGNAL PROCESSING APPARATUS AND METHODS

Attorney Docket No.: 5634.0261

Group Art Unit: 2614

Examiner: Harvey, D.

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Transmitted herewith is a Response to Interview Summary.

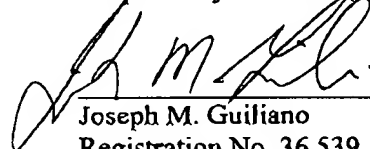
CLAIMS AS AMENDED						
	Claims Remaining After Amendment	Highest Number Previously Paid For	Extra	Rate		Amount
				Large Entity	Small Entity	
Number of Claims in Excess of 20	*	20	0	\$ 18.00	\$ 9.00	\$ 0.00
Independent Claims in Excess of 3	*	3	0	\$ 84.00	\$ 42.00	\$ 0.00
First Presentation of Multiple Dependent Claims				\$ 280.00	\$ 140.00	\$ 0.00
Extension Fee: a) One Month				\$ 110.00	\$ 55.00	\$ 0.00
b) Two Months				\$ 400.00	\$ 200.00	\$ 0.00
c) Three Months				\$ 920.00	\$ 460.00	\$ 0.00
d) Four Months				\$1440.00	\$ 720.00	\$ 0.00
e) Five Months				\$1960.00	\$ 980.00	\$ 0.00
Other:						\$ 0.00
TOTAL FEE DUE						\$0.00

- ☒ No additional fee is required.
☐ A check in the amount of \$ _____ is attached.
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FISH & NEAVE
1251 Avenue of the Americas
New York, NY 10020-1104

Respectfully submitted,


Joseph M. Guiliano

Registration No. 36,539
Attorney for Applicants
Tel.: (212) 596-9000
Fax: (212) 596-9090



Serial No. 08/470,571
Docket No. 5634.261

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : John C. Harvey and
James W. Cuddihy

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RESPONSE TO INTERVIEW SUMMARY

An Advisory Action was mailed in connection with the above-referenced application on February 14, 2002. Accompanying the Advisory Action was an Interview Summary that purports to summarize a personal interview held on September 26, 2001. The Interview Summary is inaccurate and incomplete in many respects. In addition, there are many new arguments and positions advanced by the Examiner in the Interview Summary for the first time. In the discussion below, applicants have endeavored to clarify the record with respect to inaccuracies and omissions in the Interview Summary. Applicants also provide below remarks setting forth the reasons why the new arguments and positions advanced by the Examiner are without merit. Applicants respectfully request reconsideration of the instant application in view of the following remarks.¹

¹ Applicants wish to note that none of the arguments, positions or other issues raised in the Interview Summary was applied to or otherwise discussed in connection with any specific (continued...)

I. Response To Issues Related To Support Under 35 U.S.C. § 120

A. Introduction

In Part I of the Interview Summary, the Examiner appears to attempt to set forth a test for determining whether a claim is entitled to the benefit of the filing date of an earlier application under 35 U.S.C. § 120 (2001). Applicants submit that this test and the elements which make up this test are unsupported by and contrary to the relevant legal authorities. Further, applicants submit that the Examiner's discussion of this test is rife with mistaken factual assumptions and misleading characterizations of applicants' applications and the positions taken in connection with those applications.

B. The Law Applicable to § 120

Significantly, the Interview Summary fails to cite any controlling authority to support the many statements set forth in Part I, nor has any attempt been made in the Interview Summary to harmonize those statements with established precedent. In contrast, applicants set forth their view of the proper application of 35 U.S.C. § 120 — *fully supported by citations to controlling legal authorities*.

The test to determine whether a claim is entitled to the benefit of an earlier filing date under 35 U.S.C. § 120 is straightforward:

To qualify for an earlier filing date, section 120 requires, *inter alia*, that the earlier-filed U.S. patent application contain a disclosure which complies with 35 U.S.C. § 112, ¶1 for each claim in the newly filed application. Thus, this benefit only applies to claims that recite subject matter *adequately* described in an earlier application, and does not extend to claims with subject matter

claim of the instant application or any of applicants' related applications. Applicants expressly reserve the right to further respond to the Interview Summary, and the arguments, positions and issues raised therein in the event the Examiner later chooses to reject or object to any pending claim on the basis of such arguments, positions or other issues.

outside the description in the earlier application. In other words, a claim complies with 35 U.S.C. § 120 and acquires an earlier filing date *if, and only if, it could have been added to an earlier application without introducing new matter.*

Studiengesellschaft Kohle, m.b.H. v. Shell Oil Co., 112 F.3d 1561, 1564 (Fed. Cir. 1997)

(citations omitted; emphasis added).

Section 120 imposes no requirement that a parent and a later filed application use identical or even similar passages to describe the claimed invention. In fact, the case law clearly acknowledges that claims can be supported by disclosures in the earlier and later filed applications in *different* ways:

[T]he earlier and later applications need not use identical words, if the earlier application shows the subject matter that is claimed in the later application, with adequate direction as to how to obtain it. . . . [A]n invention may be described in many different ways and still be the same invention. . . . In *In re Kirchner*, 305 F.2d 897, 904 134 USPQ 324, 330 (C.C.P.A. 1962) the court held that compliance with section 120 does not require that the invention be described in the same way, in both applications. *Id.*

Kennecott Corp. v. Kyocera Int'l, Inc., 835 F.2d 1419, 1422 (Fed. Cir. 1987).

In *In re Kirchner*, 305 F.2d 897 (C.C.P.A. 1962), the court addressed a factual scenario similar to that of applicants. Specifically, in an opinion by Judge Rich, the C.C.P.A. found that the two disclosures, while different, were not inconsistent and concluded that the applicant was entitled to the priority date of the parent application. At the end of its decision the court described the requirements of § 120:

Assuming the common inventorship, copendency, and cross-reference required by section 120, that section further requires only that the invention be disclosed in the parent application in such manner as to comply with the first paragraph of section 112 and *be* the same invention as that disclosed in the later application. It does not require that the invention be described in the same way, or comply with section 112 in the same way, in both applications.

Kirchner, 305 F.2d at 904 (emphasis in original). While the *Kirchner* case focused on the different utilities described in the two applications as required by 35 U.S.C. § 101 (2001), the *Kennecott* decision makes it clear that the same logic and analysis is equally applicable to the requirement of written description support under § 112. See *Kennecott*, 835 F.2d at 1422. Accordingly, these two decisions hold that support from the earlier and later filed applications need not be the same to comply with §§ 112 and 120 even if the earlier application is not incorporated by reference into the later filed application.

In fact, applicants have found no cases addressing compliance with § 120 which suggest that the two disclosures identified to support a claim should or need be compared for similarity in any manner. Instead, the case law discussed above establishes that such a comparison is unnecessary and indeed improper. See *Eiselstein v. Frank*, 52 F.3d 1035, 1038 (Fed. Cir. 1995) (“In order to determine whether a prior application meets the ‘written description’ requirement with respect to later-filed claims, the prior application need not describe the claimed subject matter in exactly the same terms as used in the claims; it must simply indicate to persons skilled in the art that as of the earlier date the applicant had invented what is now claimed.”).

C. The Examiner’s Test Under § 120

Rather than applying the straightforward test clearly established by the controlling authorities (as set forth above), the Examiner has instead fashioned a new test. As best applicants can discern from the Interview Summary and the August 27, 2001 Final Office Action, the new test appears to be:

1. Compare the earlier specification to the later specification.
2. If they are different, and if the earlier specification was not incorporated by reference into the later specification, automatically deny applicants’ claim of priority to the earlier application.

Instead of providing any legal authority to support this new test (which applicants believe would be impossible), the Interview Summary sets forth a litany of unsupported, self-serving statements that attempt to justify this new test. These statements, however, are either factually incorrect or contrary to the relevant legal authorities.

For example, the Interview Summary makes the following statements regarding the relationship between a claim's meaning and the disclosure:

“[The] meaning and scope of a claim's limitations are determined by the disclosure from which the claim's section 112 support is derived.” (Int. Sum. P. 2-3).

“‘[T]he claim’ defines the invention, while the disclosure defines the meaning and scope of the claim.” (Int. Sum. P. 3).

The legal authorities plainly contradict these sweeping statements: “[t]he words in a claim are generally not limited in their meaning by what is shown or disclosed in the specification.” M.P.E.P. § 2111.01 (8th ed., Aug. 2001) (citing *In re Vogel*, 422 F.2d 438 (C.C.P.A. 1970)).

The Examiner's command that “one must use the instant disclosure to determine the metes and bound [sic] the claim's limitations” (Int. Sum. P. 4), also places undue emphasis on using the disclosure to interpret the claims. Claims are generally not to be read to incorporate all of the subject matter from the specification. See *Constant v. Advanced Micro -Devices, Inc.*, 848 F.2d 1560, 1571 (Fed. Cir. 1988) (although examples from the specification may aid in interpreting a claim, “particular embodiments and examples appearing in the specification will not generally be read into the claims”). Further, “an applicant is not required to describe in the specification every conceivable and possible future embodiment of his invention.” *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1344 (Fed. Cir. 2001) (“it is the claims that measure the invention, as informed by the specification. Specifications teach. Claims claim.”). Accordingly,

the Examiner's focus on using applicants' specifications to interpret the claims in such a way to create artificial conflicts in interpreting applicants' pending claims is unjustified and unsupported by the law. See *Johnson Worldwide Assocs., Inc. v. Zebco Corp.*, 175 F.3d 985, 989 (Fed. Cir. 1999) ("words in patent claims are given their ordinary meaning in the usage of the field of the invention, unless the text of the patent makes clear that a word was used with a special meaning."); *Rexnord*, 274 F.3d at 1342 ("unless compelled to do otherwise, a court will give a claim term the full range of its ordinary meaning as understood by an artisan of ordinary skill.").

Further, on the basis of the flawed assumption that the disclosure defines the meaning and scope of the claims, the Interview Summary asserts that:

"If identically worded claims are drafted within significantly different disclosures, then it is the examiner's belief that the scope/meaning/'broadest reasonable interpretation' of these identically worded claims will (most likely) differ too." (Int. Sum. P. 3).

and

"the mere fact that the scope and meaning of each claim as defined by the current 1987 disclosure necessarily differs from the scope and meaning of each claim defined by the 1981 disclosure, is enough to deny applicant his claim to the earlier 1981 filing date; e.g. because it shows that the current 1987 scope and meaning of each claim does not constitute/encompass 'common subject matter'" (Int. Sum. P. 3).

However, the Federal Circuit has stated that "[i]t is axiomatic that, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification, and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Bond*, 910 F.2d 831, 833 (Fed. Cir. 1990) (quoting *In re Sneed*, 710 F.2d 1544, 1548 (Fed. Cir. 1983)). Accordingly, the PTO should give identically worded claims in the same art the same broad interpretation unless such interpretation is not consistent with the specification. See M.P.E.P.

§ 2111 (8th ed. 2001) (“During patent examination, the pending claims must be ‘given the broadest reasonable interpretation consistent with the specification.’”). In the instant application, the Examiner has failed to demonstrate how the broadest reasonable interpretation of any claim is inconsistent with either the 1981 or 1987 specification.

In addition to being legally suspect, the Examiner’s position articulated in the above quotes is misleading. The Examiner’s position presumes that an identically worded claim is supported by “significantly different disclosures.” However, the mere fact that two disclosures are “different” does not mean the disclosures are inconsistent, and if the differences are not inconsistent there need not be different claim interpretations. Indeed by definition, any CIP application will be different from its parent application. Often, the CIP will add significant improvements and enhancements over what is disclosed in its parent application. This common practice does not mean that CIP applicants are automatically denied the priority date of their parent applications. The important question is whether the proper test for continuity under § 120 is satisfied. Just because a CIP application is different from the parent application, even significantly different, does not automatically mean that the earlier teachings of the parent application are not included in the CIP application.

There is no suggestion in the M.P.E.P., or elsewhere in patent law, that a claim should be give one interpretation based on a parent disclosure and another interpretation based on a consistent subsequent disclosure. To the contrary, as discussed above, the Examiner is specifically instructed in the M.P.E.P. to give each claim its broadest reasonable interpretation consistent with the specification.

The following quotes address the determinative step in the Examiner’s test for priority under § 120:

“If the scopes/meanings/‘broadest reasonable interpretations’ of the respective claims do in fact differ, e.g. if the respective interpretations provided by the respective disclosures fail to perfectly circumscribe the same subject matter, the ‘*common subject matter*’” is not being claimed with respect to the two different disclosure even though the claims’ wording is identical.” (Int. Sum. P. 3).

“[F]or priority to be established, it must also [be] shown that what is being circumscribed by the pending claim(s) is ‘common subject matter.’” (Int. Sum. P. 6).

First, applicants must respectfully point out that these statements are not well understood. The notion of a patent disclosure “perfectly circumscrib[ing]” the claimed subject matter is not articulated in any published federal court opinion, as best applicants can tell after a diligent search. Applicants believe that the Interview Summary intends to argue that the scope of a given claim is limited to what is disclosed in the specification. Following this faulty premise, the conclusion seems to be that since the parent and CIP specifications are different, the claim cannot be afforded the benefit of the earlier filing date because the claim would cover more than it otherwise would. The problem with this position is that the premise is utterly unsupportable. The controlling legal authorities make clear that a claim can (and indeed often will) cover more than the disclosed embodiments. *See Gart v. Logitech, Inc.*, 254 F.2d 1334, 1343 (Fed. Cir. 2001) (refusing to read limitations from the specification into a claim and noting that “it is well established that broad claims supported by the written description should not be limited in their interpretation to a preferred embodiment”). A claim may properly cover more than what is disclosed in the CIP disclosure, more than what is disclosed in the parent disclosure, and more than what is disclosed in both. This is plainly not a proper basis to deny a claim of priority under § 120.

The Interview Summary incorrectly attempts to characterize applicants’ position on this point as follows:

“[T]he examiner strongly disagrees with applicant [sic] suggestion that a given claim is necessarily entitled to the filing date of a parent application simply by showing that the claim can read on the different disclosures of the continuing applications” (Int. Sum. P. 6).

Applicants, however, never asserted (at the interview or elsewhere) that priority is established based on “showing that the claim can read on the different disclosures of the continuing applications.” Generally, the terminology “read on” is invoked in infringement analysis for determining whether a claim covers an accused device. Applicants do not believe an analysis of whether a claim “reads on” different disclosures is the appropriate way to articulate the proper test applicable to § 120. Applicants have identified above what they believe the proper test to be.

D. The Examiner’s Application of His Test For Priority

In addition to misstating the proper test under § 120, the Interview Summary makes incorrect factual assertions about applicants’ pending applications and mischaracterizes applicants’ position with respect to those applications in applying the new test for priority to applicants’ 1981 and 1987 disclosures.

For example, the Interview Summary asserts that:

“[b]ecause each of applicants currently pending amending claims derives at least part of its section 112 support from teachings and subject matter that is found only in applicant’s current 1987 disclosure, each of the currently pending claims is (at best) only entitled to the 1987 original filing date of the current disclosure.” (Int. Sum. P. 3).

This position is incorrect for a number of reasons. First, the Interview Summary mistakenly assumes that the 1981 and 1987 specifications describe different and inconsistent inventions. In fact, both specifications describe the inventions disclosed in the 1981 specification, although the 1987 specification contains many enhancements and improvements.

Because the Interview Summary assumes the two specifications are different and inconsistent, it further and incorrectly assumes that if there is support in the 1987 disclosure, similar and valid support cannot exist in the 1981 disclosure. Both of these false assumptions lead to an incorrect conclusion.

The fact that the support identified in the 1987 specification for a certain feature (or limitation) also happens to include additional features or details relating to the same underlying feature (or limitation) disclosed in the 1981 specification, does not mean that both specifications do not support the feature or limitation with similar and valid "common subject matter" support. The mere presence of the additional details and enhancements in the 1987 specification does not deprive applicants of the 1981 priority date unless the claim limitation or feature is only supported by such additional details and enhancements which are not found in the 1981 specification. *See Kennecott*, 835 F.2d at 1422. Applicants' firmly dispute any implication by the Examiner that the pending claims for which applicants' assert a 1981 priority date derive § 112 support from subject matter that is only found in the 1987 disclosure.

Like *Kirchner*, applicants have written claims that are directed to subject matter that is found and supported in both applications. In *Kirchner*, the claim was directed to a chemical compound itself. None of the disclosed uses of that compound, which differed in the two disclosures, were ever claimed. In the instant application, the claims are directed to certain fundamental teachings that are found and taught in both disclosures. Just as *Kirchner* would not have been able to obtain priority to the parent application for claims that included limitations directed to a use of the compound that was only disclosed in the CIP application, applicants would not be entitled to a 1981 priority date for claims that include limitations directed to, and which are only supported by, details, enhancements or features only found in the 1987

disclosure. As applicants have argued, none of applicants' claims of the instant application for which a 1981 priority date is asserted are directed to the details, enhancements or features which reside only in the 1987 application. The important point on this issue is that the starting point for determining whether an applicant is entitled to priority under § 120 is *what is being claimed*. Without identifying precisely what is being claimed, it is impossible to seriously undertake an analysis of whether sufficient support exists in both applications thus entitling applicants to a 1981 priority date.

In Part V of the Interview Summary, the Examiner acknowledges that "[a]pplicant can certainly point in the direction of the 'WALL STREET WEEK' application [example] being representative of an alleged 'common theme', however the recitations of all of the introduced claims go far beyond the broad 'WALL STREET WEEK' concept." (Int. Sum. P. 10). First, the implication that the WALL STREET WEEK ("WSW") example is the only common subject matter supporting applicants' claims is false. The entire basic system in which signals are transmitted with television programming and processed at intermediate and remote stations is common to both applications. Further, in addition to the WSW example there are numerous other examples, features and components of this system that are found and disclosed in both applications including, for example, much of the "cooking show" disclosure. As applicants have repeatedly argued, all of the claims for which applicants assert a 1981 priority date are supported by these common teachings disclosed in both the 1981 and 1987 specifications.

Applicants further assert that because demonstration of sufficient written description support or lack thereof can only be accomplished in the context of a specific claim, it is entirely inappropriate for the Examiner to issue blanket rejections of applicants' priority claim without addressing precisely how a specific claim is not supported by the common disclosure cited by

applicants. *See In re Alton*, 76 F.3d 1168, 1172 (Fed. Cir. 1996) (If, on the other hand, the specification contains a description of the claimed invention, albeit not *in ipsius verbis* (in the identical words), then the examiner or Board, in order to meet the burden of proof, must provide reasons why one of ordinary skill in the art would not consider the description sufficient.).

The presence of additional details and enhancements in the 1987 specification does not require the Examiner to read such details or enhancements (limitations) into a claim when interpreting the claim for purposes of determining whether written description support exists. As already discussed, both the law and the M.P.E.P. instruct Examiners to give claims the broadest reasonable interpretation consistent with the specification. So long as additional details or enhancements present in the 1987 specification are not inconsistent with a broad claim interpretation that would be supported by both disclosures, it would be improper to use details or enhancements from the 1987 specification to interpret a claim narrowly. Accordingly, the Examiner's position is mistaken and unsupported by the law.

E. Response to Hypothetical Examples Discussed at the Interview

Part IV of the Interview Summary purports to summarize a discussion in which several hypothetical examples were considered in an effort to reach an agreement on the proper test for continuity under § 120. No claims of the instant application were discussed and no comparisons of the hypothetical examples to the claims pending in the instant application were made. For reasons not understood by applicants, the Interview Summary addresses only one of the several hypothetical examples discussed at the interview. Conspicuously absent from the Interview Summary is any reference to the simplest example discussed. In this omitted hypothetical, the parent application disclosed:

- 1) a transmitter station;
- 2) a receiver station; and

- 3) the transmission of data from the transmitter station to the receiver station using a communication protocol.

In the same hypothetical, the CIP application did not incorporate the parent by reference.

The hypothetical CIP application disclosed:

- 1) a transmitter station;
- 2) a receiver station; and
- 3) the transmission of data from the transmitter station to the receiver station using a newly invented communications protocol that is explained in detail in the CIP application, but which was not disclosed in the parent application.

It is applicants' position that if the proper legal analysis (as set forth above in section I.B) was conducted with respect to a claim in the CIP application directed to "transmitting data from a transmitter station to a receiver station using a communications protocol," such claim would likely be entitled to the benefit of the parent application's filing date (assuming the requirements of copendency, common inventorship, and cross-reference to earlier application were met). In other words, the fact that the applicant disclosed the new, inventive communications protocol in the CIP application as the way to communicate data does not automatically deprive the claim of the benefit of the earlier date. This would be the case even if the applicant admitted that the new, inventive communications protocol constituted part of the best mode of practicing the claimed invention at the time the CIP was filed (*see* section II below). To automatically deprive the applicant of the earlier date would contravene public policy by discouraging the disclosure of new inventions, and would be contrary to the Constitutional mandate to "promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. Const. art. I, § 8.

In discussing the other examples raised during the interview (including the bridge/boat example referred to in the Interview Summary), applicants specifically pointed out that the

hypothetical CIP claim *may or may not* be entitled to the benefit of the earlier filing date. The critical point is that the only way to make a determination as to priority is by conducting the proper legal analysis (as discussed in Section I.B above) — not by summarily dismissing the priority claim simply because the disclosures are different.

Significantly, the Interview Summary seems to acknowledge that in the bridge/boat example, it may be possible that generic disclosure may be found in both the parent and CIP applications that would entitle the CIP claim to the benefit of the parent's filing date (again, the only way to determine this is to conduct the proper analysis as set forth above). But rather than acknowledge an agreement on this point, the Interview Summary presents an even more far-fetched hypothetical involving train trestles and boats. Without offering any support or justification, the Interview Summary states that this new example is "a more accurate representation of the state of the present prosecution." Applicants strongly disagree with this characterization of the state of applicants' claims being prosecuted. No analysis of any kind has been provided by the Examiner to justify this bald assertion.

In contrast, the prior submissions provided by applicants on the written description support issue plainly demonstrate, on a proper claim-by-claim (and even element-by-element) basis, that common subject matter from the 1981 and 1987 specifications is relied upon to support the claims of the instant application. Moreover, these prior submissions demonstrate, contrary to the sweeping, unsupported statements made in the Interview Summary, that the fundamental teachings of the 1981 application were in fact "carried forward" into the 1987 application. Accordingly, any objection to applicants' claim of priority to the 1981 application should be withdrawn.

**F. Response to the Incorporation by Reference Issue
Discussed in the Interview Summary**

Part VIII of the Interview Summary inaccurately summarizes applicants' position concerning the incorporation of the 1981 subject matter into the 1987 disclosure. During the interview applicants informed the Examiner that they are unaware of any controlling authority that holds that a CIP application must incorporate its parent application by reference in order for the CIP claim to obtain the benefit of the parent's filing date. Applicants also cited the authority supporting applicants position that *in haec verbe* support is not required to support a claim. See *Eiselstein v. Frank*, 52 F.3d 1035, 1038 (Fed. Cir. 1995) ("the prior application need not describe the claimed subject matter in exactly the same terms as used in the claims"). No contrary legal authority has ever been cited by the PTO.

At the interview, applicants further questioned why it would be necessary to incorporate the parent disclosure, by reference or in full-text format, if the subject matter of the parent application is properly disclosed in the CIP application in an integrated manner with the enhancements and improvements of the CIP application. No response to this question was offered by the Examiner during the interview. Applicants' point is that incorporating the parent, either by reference or in full-text format, into a CIP application that discloses the subject matter of the parent in an integrated fashion does nothing more than add unnecessary duplicative content to the CIP application. As set forth above, applicants have established in their prior submissions that all of the fundamental teachings of the 1981 disclosure were in fact carried forward to the CIP application, albeit in an integrated fashion with the many enhancements and improvements of the CIP application. Thus, there was no need for applicants to explicitly incorporate the parent application into the CIP application in full-text format or by reference.

G. Response to the Interview Summary's Discussion of the Term "Programming"

Part II of the Interview Summary alleges that applicants made an admission during the interview with respect to the term "programming." Applicants respectfully submit that no such admission was made. Applicants have consistently maintained, as expressed both *before and after* the interview (see Applicants' Amendment and Request For Reconsideration filed January 28, 2002, and Amendment and Request For Reconsideration filed June 7, 2000), that there is nothing about the use of the term "programming" in the 1981 and 1987 specifications that precludes applicants from claiming the benefit of the 1981 filing date for claims that recite that term. For the reasons set forth below, the term "programming" is not used inconsistently in the 1981 and 1987 specifications.

The Examiner's assumptions about the definition of programming in the two specifications and his conclusions about the effect the of those definitions on applicants' claim to a 1981 priority date are misplaced. Particularly telling is the fact that the Examiner had to craft an entirely new definition of programming in order to advance this argument. Specifically, in the Final Office Action dated August 27, 2001, the Examiner stated that applicants' 1981 definition of programming was limited to "scheduled radio and television shows." Yet nowhere in the 1981 specification is the term so limited. Indeed, the abstract of the 1981 application states: "'Programming' here means everything that is transmitted over television or radio intended for communication of entertainment or to instruct or inform."² U.S. Pat. No. 4,694,490

² The verb "instruct" in various forms is used about 38 times throughout the 1981 specification to consistently refer to signals that control equipment. For example, at column 19, lines 48-67 of U.S. Patent 4,694,490, programming specifically includes signals that instruct the microcomputer.

Abstract, ll. 4-7. Moreover, the 1981 specification demonstrates that the term is not limited as suggested by the Examiner. The 1981 specification states:

It is the object of this invention to unlock this potential by the development of means and methods *which permit programming to communicate with equipment that is external to television and radio receivers, particularly computers and computers peripherals such as printers.*

1981 Spec., col. 1, ll. 36-41 (emphasis added); *see also* 1981 Spec., col. 4, ll. 26-28 (“Signals may also be transmitted on frequencies outside the ranges of television and radio.”)

The Examiner offers no support for his assertion in the Final Office Action that the 1981 definition is more narrow than the 1987 definition and limited to “scheduled radio and television shows.” In direct contrast to the Examiner’s narrow interpretation, the 1981 definition is expansive and, like the 1987 definition, the only type of information that does not fall under the definition is transmitted information that is not intended to entertain, instruct or inform. Other types of transmitted information besides television and radio shows that are disclosed in the 1981 specification, such as signals, codes, instructions and broadcast print in electronic format, clearly fall within the definition of programming. Such information may be embedded in a television show transmission and is intended to entertain, instruct or inform.

There is thus no basis for the Examiner to attempt to limit the 1981 definition of “programming” to “scheduled radio and television shows.” To the contrary, the 1981 definition implicitly includes, and the 1987 definition expressly includes, computer programming in the definition. As set forth above, the instruction signals disclosed in applicants’ 1981 specification (*see* col. 19, ll. 48-53 and 60-67) clearly constitute a computer program. *Webster’s Seventh New Collegiate Dictionary* (copyrighted 1977 by G. & C. Merriam Co., Springfield, Mass.) defines a program in the context of a computer as “a sequence of coded instructions that can be inserted into a mechanism (as a computer).” The instruction signals disclosed in the 1981 specification

and implicitly included within the definition of programming must be considered to be what is now, and was in 1981, widely known as a computer program or computer programming.

The instructions, codes and signals included in a television transmission clearly fall under the definition of programming. Limiting the 1981 definition of programming to “scheduled radio and television shows” directly contradicts the entire purpose of the inventions disclosed in 1981. Accordingly, applicants have not defined the term programming inconsistently in the two specifications, and their use of the term “programming” in the pending claims finds consistent and sufficient support in both the 1981 and 1987 applications.

The Interview Summary also asserts, without providing any examples or support, that other claim terms are used inconsistently in the 1981 and 1987 specifications. (Int. Sum. P. 5-6). Applicants respectfully disagree, and reserve the right to address this point further if any specific examples are ever provided.

II. Best Mode

A. The Proposed Best Mode-Based Test for Continuity Under § 120 is Unsupported

The discussion in Parts VI, VII, XI, and X of the Interview Summary asserts that applicants cannot be entitled to priority under 35 U.S.C. § 120 because applicants updated the best mode upon filing their CIP application. The best mode analysis advanced in the Interview Summary is legally flawed and not based on facts presented during the prosecution of the instant application.

The Interview Summary asserts, but fails to demonstrate, that the technology of applicants’ 1981 disclosure was not carried forward into applicants’ 1987 disclosure. Based on this erroneous assumption, the Interview Summary applies a heretofore unheard of best mode analysis to deny applicants the benefit of the 1981 priority date. Of course, if it were true that

none of the 1981 disclosure was carried forward into the 1987 disclosure, it would be axiomatic that any claims based on the 1987 disclosure would not be entitled to the benefit of priority under 35 U.S.C. § 120. But if that were the case, the Examiner would not need to resort to a novel application of the best mode requirement.

In its attempt to deny applicants the benefit of their 1981 priority filing date using a “best mode” analysis, the Interview Summary fails to take into account several fundamental principles of the best mode requirement. When these basic principles are taken into account, it should be clear that this new best mode-based test for continuity will not withstand scrutiny.

First, applicants are not required to consider one mode better than any other. *Chemcast Corp. v. Arco Industries Corp.*, 913 F.2d 923, 927-28 (Fed. Cir. 1990); *see also* M.P.E.P. § 2165 (8th ed. 2001). In the situation where an applicant does not consider one mode of practicing his invention better any other, there will be no “best mode” in the disclosure. *See Minco, Inc. v. Combustion Eng’g, Inc.*, 95 F.3d 1109, 1115 (Fed. Cir. 1996). (“Before an inventor can conceal a best mode, the record must first show his appreciation of the superiority of one mode over those modes disclosed in the specification”). There is thus no requirement that an applicant have a best mode. Rather, the requirement is *if* applicants have a best mode at the time of filing the patent application *then* that best mode must be set forth in the specification. The Examiner has not determined that applicants considered one mode of practicing the invention to be better than any other. For many of the inventions claimed in this and applicants’ related applications, applicants’ did not consider any particular embodiment to be better than any other.

Second, even if applicants have a best mode, they are not required to identify which disclosed embodiment is the best mode. *See* M.P.E.P. § 2165.01 III (citing *Ernsthausen v.*

Nakayama, 1 USPQ2d 1539, 1549 (Bd. Pat. App. & Inter. 1985)). Thus, if several embodiments are disclosed, any unknown one may be the best mode (assuming the inventor had one at all).

Third, the M.P.E.P. specifically acknowledges that these issues³ are very unlikely to be known to the Examiner:

“The information that is necessary to form the basis for a rejection based on the failure to set forth the best mode is rarely accessible to the examiner”

“There is no requirement in the statute that applicants point out which of their embodiments they consider to be their best; that the disclosure includes the best mode contemplated by applicants is enough to satisfy the statute.”

“The absence of a specific working example is not necessarily evidence that the best mode has not been disclosed, nor is the presence of one evidence that it has.”

“The failure to disclose a better method will not invalidate a patent if the inventor, at the time of filing the application, did not know of the better method OR did not appreciate that it was the best method.”

M.P.E.P. §§ 2165 - 2165.03.

The Interview Summary offers nothing to demonstrate how these barriers can be overcome in conducting the Examiner’s new best mode-based test for continuity. Instead, *for each claim*, the Examiner is forced to: 1) assume that applicants had a best mode in 1981; 2) guess at what that best mode might have been; 3) assume applicants had a best mode in 1987;

³ Another issue related to best mode concerns the allegation that an applicant has concealed the best mode during prosecution. *See* M.P.E.P. § 2165.04 (in determining the adequacy of a best mode disclosure, *only* evidence of concealment is to be considered by the Examiner). Applicants have not concealed any preferred embodiment from the public, nor has the Examiner asserted that they have. To the contrary, the Examiner proposes to penalize applicants for providing later conceived embodiments in the CIP application. The Examiner’s attempt to penalize applicants for providing additional disclosure is antithetical to the best mode requirement, which promotes the full disclosure of the invention in return for the exclusive rights bestowed by the patent grant.

4) guess at what that best mode might have been; and 5) surmise, based on these unsupported assumptions and guesses, that the hypothetical best mode changed from 1981 to 1987.

The new test proposed by the Examiner is plainly unworkable. It should come as no surprise that applicants have been unable to locate a single case that even arguably supports this test. Applicants respectfully request consideration of the following point: if it is assumed, *arguendo*, that applicants had no best mode in 1981 or in 1987 for a given claim (i.e., that applicants considered no embodiment better than any other for a given claim), what would be the outcome of the newly proposed best mode-based test for continuity? Clearly, the test does not work. Accordingly, applicants request that this test no longer be applied, and that applicants' claim of priority to the 1981 application be properly examined — on a claim-by-claim basis — under the clear guidelines established in the controlling authorities discussed in Section I.B above.

B. The Examiner's Best Mode Analysis is Based on Unsupported Assumptions

Notwithstanding the fact that the Interview Summary's test for continuity based on the best mode is fundamentally flawed, the application of the test to the instant circumstances is based on numerous errors and unsupported assumptions. The Interview Summary states that "it appears that 'SPAM' represents the 'best mode' that was described within applicant's instant 1987 disclosure whereas something other than 'SPAM' represents the 'best mode' that was described in applicant's 1981 disclosure; i.e. . . . assuming that the best mode was described in both applications." (Int. Sum. P. 12). To reach this conclusion, the Interview Summary must improperly assume that: 1) that applicants had a best mode of carrying out the invention; 2) that the disclosure has a single best mode for all of applicants' pending claims; and 3) that applicants chose to update their best mode (if one exists) in their CIP application. (Int. Sum. P. 11).

As an initial matter, without reference to a particular claimed invention it is impossible to state whether applicants did or did not contemplate a best mode of carrying out the invention. Accordingly, each of the three erroneous assumptions are flawed because they bypass any attempt to first identify the claimed invention. “[T]he first task in any best mode analysis is to define the invention at hand.” *Northern Telecom Ltd. v. Samsung Elecs. Co.*, 215 F.3d 1281, 1286 (Fed. Cir. 2000). Both the 1981 specification and the 1987 specification describe systems with multiple configurations and operations. It simply cannot be said which of these configurations and operations, if any, were considered by applicants to be the best mode without reference to a claim that defines the invention at issue. It is error for the Examiner to make any assumptions about a best mode by reference only to the disclosure without identifying the invention at issue.

C. The Examiner Mischaracterizes Applicants’ Disclosures

In addition to the erroneous assumptions, the Interview Summary incorrectly characterizes the 1981 and 1987 disclosures. The Interview Summary states “the 1987 disclosure and the 1981 disclosure represent different ‘best modes’: e.g. the ‘on’/‘off’ trigger/cueing signals of the 1981 disclosure were replaced by ‘SPAM’, the circuit configurations of the 1981 disclosure were replaced by 1987 circuit configurations, new modes for processing ‘SPAM’ were incorporated into all the added 1987 illustrated structures, etc.” (Int. Sum. P. 13). The fact that applicants’ CIP application includes new matter is not evidence that applicants did not carry forward previously disclosed modes of carrying out the claimed inventions. Many of the signals described in the 1987 specification under the discussion of SPAM perform the same functions in the same systems as signals described in the 1981 specification. Although the drawings of the 1987 specification are updated with respect to the

drawings of the 1981 specification, there are many illustrated features that remain exactly the same (for example, compare 1987 Spec. Fig. 2 and U.S. Patent No. 4,694,490 Fig. 1 which are substantially identical) and many other close similarities between the drawings (for example, compare 1987 Spec. Figs. 6A & 6B and U.S. Patent No. 4,694,490 Figs. 3A, 3B & 3C). Specific structures of "SPAM" signals and new manners of processing them were disclosed in the 1987 specification, however, there is no support for the assumption applicants replaced the disclosure of a best mode of carrying out a claimed invention with the added matter. To the contrary, applicants may not have had a best mode or the best mode may have been described in the subject matter that is included in both the 1981 specification and in the 1987 specification. Again, it is impossible to make this determination without reference to a particular claimed invention.

The Interview Summary asserts that "the validity of all of the currently pending claims necessarily rests on 'SPAM', e.g. being that 'SPAM' was introduced via the 1987 disclosure and comprises all of the control/instruct signals that are transmitted by the 1987 alleged inventions, all of the currently pending claims only get the 1987 filing date." (Int. Sum. P. 13) This premise is unsupported and wrong. Although the term "SPAM," which stands for signal processing apparatus and methods (see 1987 Spec. p. 40, l. 21-23), was introduced in the 1987 disclosure, all of the control and instruct signals so labeled were not introduced in the 1987 disclosure. Many of the control signals and instruct signals labeled "SPAM" in the 1987 disclosure were originally disclosed in the 1981 disclosure⁴ (for example, compare U.S. Pat. No 4,694,490, col. 2, l. 64 - col. 3, l. 12 and col. 4, ll. 36-46 with 1987 Spec., p. 14, l. 25 - p. 15, l. 6 and p. 40, l. 16 - p. 43, l. 23; further details of SPAM signal structure disclosed at p. 43, l. 30 - p. 84, l. 23).

⁴ In fact the title of the 1981 application is "Signal Processing Apparatus and Methods."

Accordingly, the validity of claims directed to “SPAM” signals do not rest on new matter introduced in the 1987 CIP disclosure.

Part X of the Interview Summary states, “[T]he old system configurations and the old transmission system technology of the 1981 disclosure were not carried forward into the 1987 disclosure.” To the contrary the system configurations and the transmission system technology of the 1981 disclosure were carried forward into the 1987 disclosure. Applicants have demonstrated this with regard to specific claimed subject matter in prior submissions in this and many of applicants’ related applications. It is error to make a blanket, wholly unsupported statement that subject matter was not carried forward. The Examiner’s statement that subject matter was not carried forward must be directed to specific claimed subject matter. The statement should also be the conclusion of an argument properly supported by evidence on the record of the application. It is improper for the Examiner to simply presume that claimed subject matter was not carried forward as a foundation for constructing any rejection under the first paragraph of 35 U.S.C. § 112.

D. The Examiner Misinterprets *Transco*

The Interview Summary attempts to rely on the following quote from the *Transco* decision:

It must be understood that the introduction of a new best mode disclosure would constitute the injection of “new matter” into the application and automatically deprive the applicant of the benefit of the earlier filing date of the parent or original application for any claim whose validity rests on the new best mode disclosure.

Transco Products Inc. v. Performance Contracting, Inc., 38 F.3d 551, 558 (Fed. Cir. 1994). The Interview Summary grossly misinterprets the above quote, which simply stands for the well-established proposition that an applicant cannot claim the benefit of an earlier date if the earlier application does not support the claim under § 112. Significantly, the Interview Summary

acknowledges that the above quote is *dicta* and not authoritative with respect to the new best mode-based test for continuity set forth in the Interview Summary. Given that (i) the one cited case has been admitted to be non-authoritative, and (ii) no other supporting authority has been provided, the new best mode-based test for continuity under § 120 set forth in the Interview Summary must be considered without merit and therefore withdrawn and not further applied.

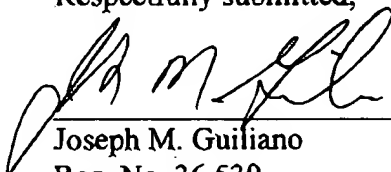
III. Conclusion

Applicants have demonstrated in the foregoing remarks that the various legal theories advanced by the Interview Summary relating to continuity under § 120 are unsupported, and are indeed contrary to the controlling legal authorities. Moreover, applicants have set forth the proper test for continuity, and have established in these remarks and in prior submissions why those claims of the instant application for which applicants assert a 1981 priority date are entitled to the benefit of the 1981 filing date. Reconsideration and allowance of the instant application are therefore respectfully requested.

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FISH & NEAVE
1251 Avenue of the Americas
New York, New York 10020

Respectfully submitted,



Joseph M. Guiliano
Reg. No. 36,539
Tel.: (212) 596-9000
Fax: (212) 596-9090